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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/550,819

06/21/2006

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49288.1500

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20322 7590 07/06/2011  
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EXAMINER

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ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

07/06/2011

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/550,819  
Filing Date: June 21, 2006  
Appellant(s): WATANABE ET AL.

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Alex Starkovich  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/19/2011 appealing from the Office action mailed 11/22/2010.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 1-3, 5-7, 9, 10, 12-14, 18, and 19 are pending and under rejection.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

**(8) Evidence Relied Upon**

|              |               |         |
|--------------|---------------|---------|
| 6,234,448    | Porat         | 5-2001  |
| 2002/0177863 | Mandel et al. | 11-2002 |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 5-7, 9, 10, 12-14, and 18-29 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,234,448 (Porat).

Porat discloses a device that includes all the claimed structural features and is capable of being used as a surgical holder for grasping tissue. The device illustrated in Figure 2 has a first grasping plate (30) and a second grasping plate (20) that form a first grasping portion at one end of the device (left hand side) and a second grasping portion (right hand side) at the other end of the device. The first grasping portion is defined between a U-shaped opening (56) in the first plate (30) and a covering portion (21) of the second plate (20). Rectangular tabs (85) of the top plate extend outwardly beyond the bottom plate to form "non-covering portions." The U-shaped opening (56) is defined on either side by a pair of elongated edge portions (50 and 60). Each end (58 and 68)

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of each edge portion (50 and 60) is *capable of* being inserted into a tubular tissue. The second grasping portion is defined between a “recessed portion”, or curved cut-out (36), in the first plate (30) and a corresponding curved portion (26) in the second plate (20) that form a generally tubular tissue grasping space (44). Regarding the preamble, the device can include a manipulation member, or tab (70), connected to the grasping member by a “connecting portion” (part of tab 70).

Claims 1 and 6 recites functional language that is not given full patentable weight. As long as the prior art includes all the structural features and has the capability of performing the recited functions, it meets the claim requirements. In this case, Porat discloses a device that is configured for grasping a tubular object (90), as shown in Figures 4, 5, 6B, 6C, 7B, and 7C. Porat illustrates that a tubular object (90) may be grasped by passing through the U-shaped opening of the first grasping portion of the device (left hand side in Figure 2) and passing through the tubular grasping space (44) of the second grasping portion (right hand side in Figure 2), which is similar to the use of the claimed device disclosed by Applicant in Figure 10.

The Porat device also has the capability of being used to grasp tissue by inserting each end (58 and 68) of each edge portion (50 and 60) into a tubular tissue for performing the function of grasping the tissue. Applicant discloses that the mere act of inserting the elongated edge portion into the tissue results in grasping tissue (paragraph 111 and Figure 11). Porat illustrates that a tubular tissue (90) has a diameter similar to that of the U-shaped opening and the width of the U-shaped opening is similar in width to each of the edge portions (50 and 60). Therefore, it can be readily understood that

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each end (58 and 68) of each one of the edge portions (50 and 60) has a width that allows for its insertion into the tubular object (90). Additionally, Porat includes catch members (52 and 62) that provide the edge portions (50 and 60) with the capability of grasping the tubular tissue by engaging the inner wall of the tubular tissue. Further, it is commonly known that tubular tissues exist in wide range of sizes and shapes, as variables include type of tissue, species, age and size of the patient, etc. Therefore, each end (58 and 68) of the elongated edge portions (50 and 60) have the capability of being "inserted into a tube of a tubular tissue for grasping the tubular tissue" of an appropriate size in a similar manner that is illustrated in Figure 11 of the current application.

Regarding claim 5, both plates (20 and 30) make up the grasping member, which has a rectangular shape as viewed from a top surface of one of the plates.

Claims 7, 9 and 10 recite language directed toward the intended use of the device that is not given full patentable weight. The surrounding tissue recited in claim 7 is a recitation of intended use and not required to be disclosed by the prior art. The Porat device is *capable of* engaging any tissue surrounding the tubular tissue with an elongated edge portion (50 or 60) and the covering portion (21) in a similar fashion disclosed in Figure 8 of Applicant's disclosure. Porat shows that the device is also *capable of* grasping tissue in the manner required by claim 9, wherein a portion of the tube (90) is grasped between the U-shaped opening (56) and covering portion (21) (left hand side in Figure 7B) and another portion is grasped in the tissue grasping space (44) (right hand side in Figure 7B). As discussed above, each end (58, 68) of an edge

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portion (50, 60) is *capable of* being inserted into a tubular tissue, as required by claim 10.

Regarding claims 12-14, the term “a thickness” is sufficiently broad enough to encompass any portion of the first plate. Since the recessed portion is recessed towards some part of the plate with a thickness, Porat meets this claim.

Claims 21-23 only recite limitations directed towards the intended use of the device and are not given patentable weight. Since the Porat device is *capable of* accommodating a range of sizes of tubular objects and blood vessels exist in a wide range of sizes, the Porat device is capable of accommodating a tubular blood vessel.

Regarding claims 24-26, the generally tubular tissue grasping space (44) is defined between a “recessed portion”, or curved cut-out (36), in the first plate (30) and a corresponding curved portion (26) in the second plate (20). The limitation “a plane defined by the remaining portion of the first grasping plate” is significantly broad enough to encompass a variety of planes. Therefore, the recessed portion (36) could be described as an indentation in a plane. The limitation “the remaining portion of the second grasping plate” is significantly broad enough to encompass a variety of portions of the second plate. Therefore, the curved portion (26) could be described as “raised” relative to a portion of the second plate (20). The phrase “for grasping blood vessels” is a recitation of the intended use of the device, which is not given full patentable weight. Nonetheless, Porat discloses grasping tubular objects in the tubular tissue grasping space (44) and is capable of accommodating a tubular blood vessel.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porat in view of Mandel et al. (US 2002/0177863).

Porat fails to include a tissue protection material attached to the grasping plates that is permeated with a medicine. Mandel et al. disclose providing an antimicrobial and/or antibiotic coating to the surfaces of various types of surgical clips in order to prevent and kill microorganisms in the area of the clip (paragraphs 33 and 34). It would have been obvious to one of ordinary skill in the art to include a tissue protecting coating containing antibiotic or anti-microbial medicines on the Porat device, as taught by Mandel, in order to prevent growth and to kill microorganisms in the area of the clip.

#### **(10) Response to Argument**

Applicant argues on page 9 that Porat fails to disclose or contemplate that the elongated edge portion (50 or 60) is *"configured to be inserted into a tube of a tubular tissue for grasping the tubular tissue"*, as required by claim 1. This functional language recited in claim 1 is not given full patentable weight. The prior art meets the requirement by disclosing all the claimed structural components and having the capability of performing the recited function. Applicant discloses that the act of inserting the elongated edge portion into the tissue provides the function of grasping tissue (paragraph 111 and Figure 11).

Porat includes all the claimed structures, as explained in detail above, and the device has the capability of being manipulated in the manner recited in the claims. Porat is not required to disclose the function of inserting an end of one of the elongated



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portions (50 and 60) into a tubular object, but only have the capability of functioning in this manner. In addition to holding a tubular object (90) between the two elongated edge portions (50 and 60), as illustrated in Figure 7B, the end (58 and 68) of each one of the edge portions (50 and 60) is also capable of being inserted into a tubular object. Porat illustrates that a tubular object (90) has a diameter similar to that of the U-shaped opening and the width of the U-shaped opening is similar to the width of each of the edge portions (50 and 60). Therefore, it can be readily understood that each end (58 and 68) of each one of the edge portions (50 and 60) has a width that allows for its insertion into the tubular object (90). If inserted into a tubular tissue, the catch members (52 and 62) on each elongated edge portion (50 and 60) provide the device with the capability of grasping the tubular tissue by engaging the inner wall of the tubular tissue. Further, it is commonly known that tubular tissues exist in wide range of sizes and shapes, as variables include type of tissue, species, age and size of the patient, etc. Therefore, each of the ends (58 and 68) of the elongated edge portions (50 and 60) has the capability of being inserted into a tubular tissue that has an appropriate diameter for engagement by the elongated edge portion. Performing this action would result in grasping of the tubular tissue by engagement of the catches (52 and 62) on the elongated edge portions (50 and 60) with the inner wall of the tubular tissue. Therefore, the Porat device is capable of performing all of the recited functions of the claims.

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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/SARAH WEBB/

Examiner, Art Unit 3731

Conferees:

/S. Thomas Hughes/  
Supervisory Patent Examiner, Art Unit 3731

/Eric Nicholson/  
RQAS -3700